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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,272	02/06/2004	Christoph Andreas Roth	008932-0876-999	8488
51832	7590	11/01/2005		
JONES DAY 222 EAST 41ST STREET NEW YORK, NY 10017-6702			EXAMINER SWIGER III, JAMES L	
			ART UNIT	PAPER NUMBER

3733

DATE MAILED: 11/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/774,272	Applicant(s) ROTH ET AL.	
	Examiner James L. Swiger	Art Unit 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/6/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

There exists an inconsistency between the language of claim 1 and that of the claim 2 dependent thereon, thus making the scope of the claim unclear. In the preamble of claim 1, lines 1-2, the applicant recites "a mechanism for coupling a first fracture fixation implant to a second fracture fixation implant." In claim 2, line 3, the applicant recites that the "second implant defines a second engagement surface." As stated, the applicant is claiming the combination of the mechanism and the implants, where the subcombination is simply the mechanism.

As such, it is unclear whether applicant intends to claim the subcombination or combination. Applicant is hereby required to indicate to which, combination or subcombination, the claims are intended to be directed, and amend the claim such that the language thereof is consistent with this intent. For examination purposes, claims 1-34 will be considered as being drawn to the combination: mechanism and implants.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent

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granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 6,9,10-12,13-19,20-22,30-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Asher et al (U.S. Patent No. 5,257,993). Asher et al. discloses a device having a mechanism (Fig. 1) comprised of a body member (22), a single prong (28), and a drive member (60a). The device of Asher et al. is also capable of having a first and second engagement surface and is capable of a location within a longitudinal channel and tabs (68a and 70a). The disclosed device also has a bore area (32a), and a substantially cylindrical portion (26a). The device of Asher et al. also discloses a drive member that is rotatable (Col. 7, line 42) and functions with an end cap (24). Finally, Asher et al. discloses a cannulation for use in a guidewire (See Fig. 1 below).

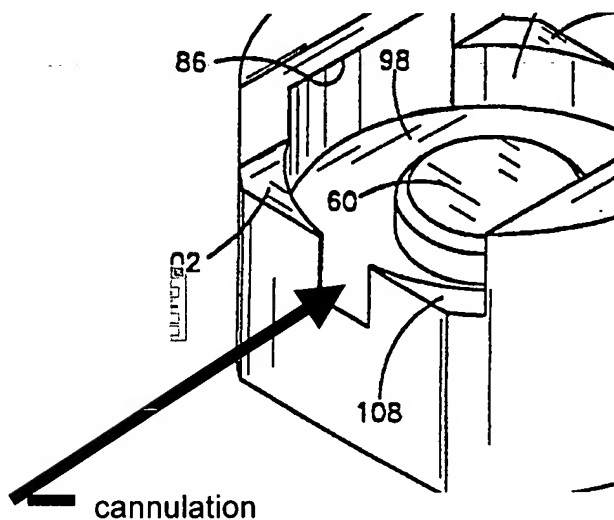


Figure 1.

Claims 1-9,13-18 and 23-29,33-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Fujiwara (U.S. Patent No. 6,406,477). For claims 1-9,13-18, Fujiwara discloses a device having a mechanism (See Fig. 2 below).

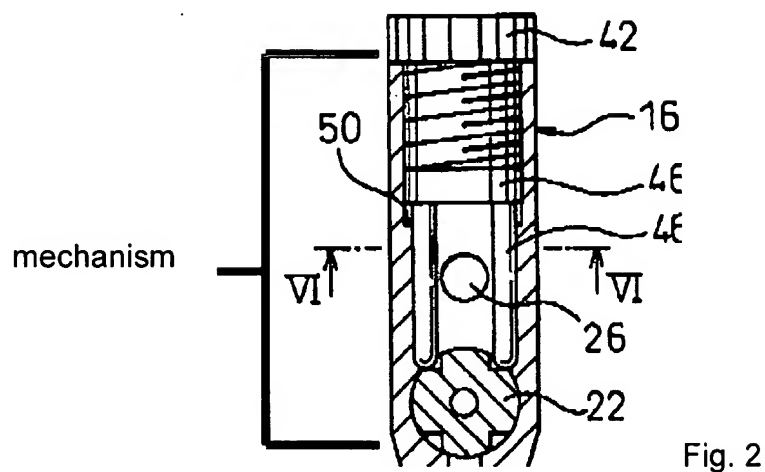


Fig. 2

Fujiwara also discloses a device having a body member (46a), a single prong (46), drive member (40), a first and second engagement surface (Fig. 2), a longitudinal channel (16b), stops (34), a bore (26), a predetermined angle with the first longitudinal axis (see Fig. 3 below), a drive member (42) that is rotatable and threadably engages the first implant, and has an end cap (top section of 42).

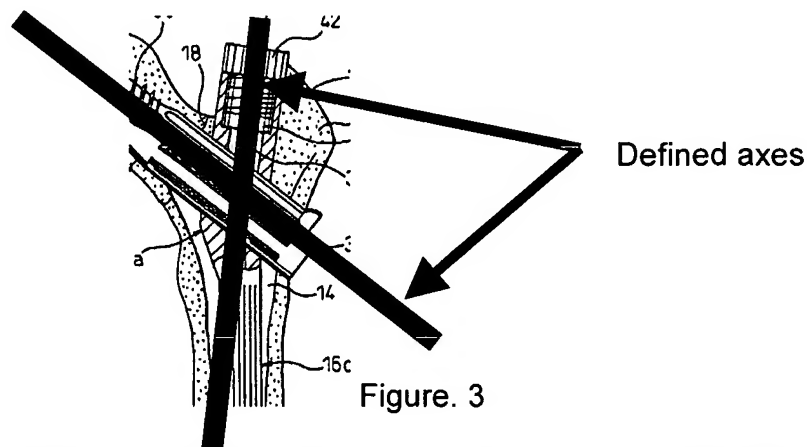


Figure. 3

The device of Fujiwara anticipates the device further. For claims 23-29, 33-34, the reference '477 teaches a body member, a first and second prong (Fig. 4), and a drive member (40). The first and second prongs are substantially parallel, the second prong is substantially zero in length, and both substantially prevent the rotation and/or

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sliding of the second implant. The word "substantially" functions as an indefinite term in this situation, and is examined in the broadest reasonable interpretation. The mechanism also extends through a bore in the first implant at the intersection of the axes in Fig. 3, and an end cap (top of 42).

Conclusion


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See attached PTO-892 for additional references.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James L. Swiger whose telephone number is 571-272-5557. The examiner can normally be reached on Monday through Friday, 8:30am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


EDUARDO C. ROBERT
PRIMARY EXAMINER

 10/27/05